

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks herewith, which place the application into condition for allowance. The present remarks are being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-22 and 28-30 are pending in this application. Claims 1, 10, 18-22 and 28-30 are independent. Claims 23-27 and 31 have been canceled without prejudice or disclaimer of any subject matter. No new matter has been introduced. It is submitted that these claims, as originally presented, were in full compliance with the requirements of 35 U.S.C. §112. Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-20 and 28 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,774,170 to Hite, et al. (hereinafter, merely “Hite”) in view of U.S. Patent No. 7,039,930 to Goodman, et al. (hereinafter, merely “Goodman”) and further in view of U.S. Patent No. 5,872,588 to Aras, et al. (hereinafter, merely “Aras”) and U.S. Patent No. 6,698,020 to Zigmond, et al. (hereinafter, merely “Zigmond”).

Claims 21 and 29 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Hite in view of Goodman and further in view of Zigmond.

Claims 22 and 30 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Hite in view of U.S. Patent No. 5,530,754 to Garfinkle (hereinafter, merely "Garfinkle") and further in view of Zigmond.

Claim 1 recites, *inter alia*:

"An image content providing method of providing an image content from an image content providing apparatus to an image content reproducing apparatus...

distributing said advertisement image at the position of inserting said advertisement image when said image content is distributed from said image content providing apparatus to said image content reproducing apparatus, and

selecting the advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select said advertisement image or reject said advertisement image and select a different category." (Emphasis added)

As understood by Applicant, Hite relates to enhancing television (and radio) advertising by targeting, delivering and displaying electronic advertising messages (commercials) within specified programming in one or more pre-determined households (or on specific display devices) while simultaneously preventing a commercial from being displayed in other households or on other displays for which it is not intended.

As understood by Applicant, Goodman relates to a media advertising automatic billing system which automatically and securely maintains an exact tracking of advertisements which are played and produces billing information for those advertisements.

As understood by Applicant, Aras relates to a universal audio-visual identification code embedded in audio-visual materials, a software system residing in the home station to monitor and record the viewing of these audio-visual materials and returning the collected data to a behavior collection center for interpretation, accumulation and processing.

As understood by Applicant, Garfinkle relates to a video-on-demand system in which catalog data is periodically transferred to the user sites, where it is stored. The catalog data includes listings of the video products available at the central station, so-called trailers or previews for certain of the video products, and lead-ins for the initial portions of certain products to provide a seamless lead in to program material ordered from the central station.

As understood by Applicant, Zigmond relates to selecting and inserting advertisements into a video programming feed at the household level.

Applicant respectfully submits that Hite, Goodman, Aras, Garfinkle and Zigmond, taken either alone or in combination, do not teach or suggest the above-identified features of claim 1. Specifically, Hite, Goodman, Aras, Garfinkle and Zigmond do not teach or suggest selecting the advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select said advertisement image or reject said advertisement image and select a different category, as recited in independent claim 1.

Page five of the Office Action states that “Hite, Goodman, and Aras do not disclose selecting an advertisement image...such that a viewer can select advertisement image or reject said advertisement image and select a different category.” The Office Action further states that Zigmond discloses the above limitation. However, the relied upon portion of Zigmond (column 9, lines 30-38) merely discloses that “the viewer may be presented with multiple ads and asked to select one for viewing.” Zigmond does not teach or suggest that the advertisement image was selected based on viewer information set at the image content reproducing apparatus and that a viewer can reject an advertisement image and select a different category.

Therefore, independent claim 1 is patentable.

For reasons similar to, or somewhat similar to, those described above with regard to independent claim 1, independent claims 10, 18-22 and 28-30 are also believed to be patentable.

III. DEPENDENT CLAIMS

The other claims in this application are each dependent from one of the independent claims discussed above and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosures in the cited reference, or references it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

By 
Thomas F. Presson
Reg. No. 41,442
(212) 588-0800